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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,884	07/21/2003	Rickey D. Hart	INNO-4 CON 8	6383
7590	06/23/2005		EXAMINER	
Mark J. Pandiscio Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02451-1914			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/623,884	HART, RICKEY D.
Examiner	Art Unit	
Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 May 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

Art Unit: 3731

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 9, 2005 has been entered.

It is noted that new limitations in the claims were not underlined (to indicate that they are newly presented) as required.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the guide means defined in claim 1, lines 14-15, 28-29 and 38-42 and similarly in claim 4. There is no indication in the original disclosure that the second wire-like element guides the cord-like object into engagement with the hook-shaped distal end of the first wire-like element as opposed to, for example,

Art Unit: 3731

merely retaining the cord-like object within the hook after the cord has entered the hook. The term "guide" requires the cord-like object to contact the second wire-like element prior to engagement with the hook-shaped distal end of the first wire-like element. The original disclosure nowhere discloses this function for the second wire-like element.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,026,379) in view of Yoon (5,226,426). Yoon (5,026,379) shows a device 10 for grasping thin cord-like objects (such as Fallopian tubes or vas deferens as described in col. 1, lines 6-15) comprising hollow rigid shaft 14, solid rod 12, first and second wire-like elements (the forceps jaws shown in figure 25 or figure 26, for example), the first wire-like element (the lower jaw in either figure 25 or figure 26) comprising a proximal segment (the right half of the lower jaw) and a distal segment (the left half of the lower jaw) defining a hook-shaped configuration, the second first wire-like element (the upper jaw in either figure 25 or figure 26) comprising a proximal segment (the right half of the upper jaw) and a distal segment (the left half of the upper jaw) defining a guide means, the first wire-like element distal segment extending in a direction toward the second wire-like element

Art Unit: 3731

distal segment (noting in figure 26 the very short straight segment at the end of the curved hook which points to the upper jaw) and substantially normal to said second wire-like element distal segment (i.e., normal to the main portion of the distal segment which extends diagonally upward from the bottom right to the top left) and activation means 32. Yoon (5,026,379) fails to show the distal end of shaft 14 as being pointed. However, making the Yoon (5,026,379) hollow shaft 14 pointed in order to more easily penetrate tissue would have been obvious in view of the Yoon (5,226,426) teaching of providing such a point 46 on hollow shaft 32 apparently for this reason. Note figures 9-10 of Yoon (5,226,426) which show grasping means 132,134. As to claim 2, the distal end of the Yoon (5,026,379) shaft 14 is curved since the prongs formed by slot (col. 6, line 62 to col. 7, line 7) are curved in the circumferential direction since the cross-section of the shaft 14 is circular.

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,026,379) in view of Yoon (5,226,426) as applied to claim 1 above, and further in view of Hasson (4,174,715). Yoon (5,026,379) fails to show a spring. Providing a spring to automatically retract the Yoon (5,026,379) wire-like jaws inside the shaft in order to make the instrument

easier to operate would have been obvious in view of the Hasson teaching of providing spring 44 for this reason.

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

This is a continuation of applicant's earlier Application No. 09/742,023. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

Art Unit: 3731

event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

mht
6/21/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731